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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,311	01/04/2002	Takehisa Kato	P 290460 T2TYA-97S0351-1C	2529
7590 Pillsbury Winthrop LLP Intellectual Property Group 1600 Tysons Boulevard McLean, VA 22102			EXAMINER CALLAHAN, PAUL E	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/035,311	<b>Applicant(s)</b> KATO ET AL.	
	<b>Examiner</b> Paul Callahan	<b>Art Unit</b> 2137	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29, 34-36, 38 and 41-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 34-36 and 41-47 is/are allowed.
- 6) ☐ Claim(s) 29, 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 29, 32-36, 38, and 41-47 were pending in the instant application at the time of the previous Office Action, mailed February 1, 2007. By the latest reply, filed May 30, 2007, claims 32, 33 are cancelled. Therefore claims 29, 34-36, 38, and 41-47 remain pending in the instant application and have been examined.'
2. The indicated allowability of claims 29 and 38 are withdrawn in view of a reconsideration of the prior art of Gammie et al., International Application EP 0 679 029 A1. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 29 and 38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gammie et al., International Application EP 0 670 029 A1.

As for claims 29, the claim is directed to a recording medium manufacturing method. As such, the claim is of the Product-By-Process type. From MPEP Sec. 2113[R-1]: "[E]ven though product-by-process claims are limited by and defined by the

*process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production.*" The limitation of: "...and selecting part of said plurality of second keys as said p number of second keys for use in enciphering said first key in a case where part of said plurality of second keys has been broken..." should not be given patentable weight since it does not affect the manner in which data is stored on the medium. The selection of a p number of second keys for use in enciphering first keys in the event that the plurality of second keys "*has been broken*" does not affect the storage of enciphered first keys since they are recited by the claim as *always* being enciphered with the plurality p of second keys. Gammie teaches the remaining claim limitations of: keeping a plurality of second keys (page 6 lines 1-29, 55-58, page 7 lines 15-45); obtaining first information composed of enciphered data by enciphering data with a first key (page 6 lines 1-29, 55-58, page 7 lines 15-45); obtaining second information composed of a p number of enciphered first keys (page 6 lines 1-29, 55-58, page 7 lines 15-45), where p is an integer greater than or equal to two (page 6 lines 1-29, 55-58, page 7 lines 15-45), obtained by enciphering said first key with a p number of second keys of the kept plurality of second keys (page 6 lines 1-29, 55-58, page 7 lines 15-45), respectively; and recording said first and second information on the same recording medium (page 6 lines 1-29, 55-58, page 7 lines 15-45).

As for claim 38, the claim is directed towards the enciphering method utilizing the recording medium of claim 1. Claim 38 recites substantially the same limitations as

claim 1 and is therefore rejected on the same basis as is that claim. The limitation of *"...and selecting part of said plurality of second keys as said p number of second keys for use in enciphering said first key in a case where part of said plurality of second keys has been broken..."* should not be given patentable weight for essentially the same reasons discussed supra in the rejection of claim 29. The claim is worded in such a manner that the plurality p of second keys is always used to encipher the first keys, whether or not they have been "broken."

#### ***Allowable Subject Matter***

5. Claims 34-36 and 41-47 are allowed.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



/Paul Callahan/

August 31, 2007



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER